



AUG 6 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 22, 41 and 46 of the morning section and questions 8 and 21 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On February 2, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a

statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for questions 22, 41 and 46 of the morning section and questions 8 and 21 of the afternoon section. Petitioner's arguments for these questions are addressed individually below.

Morning question 22 reads as follows:

22. Which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Appeals and Patent Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Appeals and Patent Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

The model answer is selection B.

See MPEP § 1209, p.1200-23, "Participation by Examiner." As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)

Petitioner argues that answer (E) is correct. Petitioner contends that MPEP § 1209 requires more than the examiner expressing a desire, and requires particular conduct on the part of the examiner.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that MPEP § 1209 requires more than the examiner expressing a desire, and requires particular conduct on the part of the examiner, the selection (B) states that oral arguments *may* be presented. As petitioner admits, the material in selection (B) is a verbatim transcription from the MPEP. The examiner's request may be insufficient in itself, but the request does open the door so that the examiner may resent oral participation. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 41 reads as follows:

41. Which of the following is true?

- (A) The statement, "Whether claims 1 and 2 are unpatentable," complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (D) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (E) In an ex parte reexamination proceeding, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

The model answer is selection D.

See 37 C.F.R. § 1.196(b); MPEP § 1214.01. As to (A) see MPEP §1206, p.1200-8, "(5) Summary of Invention." As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (C) see 37 C.F.R. § 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted ex parte after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

Petitioner argues that answer (A) is correct and (D) incorrect. Petitioner contends that selection (A) unfairly tests whether omitted elements are required and that petitioner assumed that selection (A) could be completed outside the scope of the exam question. Given this, petitioner contends that multiple claims can be appealed rendering selection

(A) true. Petitioner further contends that (D) is incorrect because a rehearing is not granted automatically on the basis of a request.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (A) unfairly tests whether omitted elements are required and that petitioner assumed that selection (A) could be completed outside the scope of the exam question and that (D) is incorrect because a rehearing is not granted automatically on the basis of a request, the instructions specifically state "Do not assume any additional facts not presented in the questions", selection (A) states that the quoted fragment complies, not that the segment as augmented by an assumed completion complies, and selection (D) states that an appellant may request a rehearing, not that a rehearing is granted. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 46 reads as follows:

46. Which of the following statements regarding an applicant's duty to submit a drawing in a U.S. patent application is true?

I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.

II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.

III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

- (A) I
- (B) II
- (C) III
- (D) II and III
- (E) I, II, and III

The model answer is selection D.

35 U.S.C. § 113; MPEP § 608.02(a), under heading "Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113," p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

Petitioner argues that answer (C) is correct. Petitioner contends that (II) is incorrect because a drawing submitted subsequent to filing is an amendment and therefore is not in a patent application, but is rather in a file. Petitioner bases this assertion on petitioner's definition of a patent application as an application as filed and not as amended.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a patent application is an application as filed and not as amended, petitioner provides no support for this statement. The MPEP shows this statement is inconsistent with Office practice, e.g. MPEP 502 "It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried ...". Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 8 reads as follows:

8. In early 1998, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1998. In August 1999, MC files a patent application in the United States for the reverse automobile heating system. In December 1999, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1998. Which of the following is true?

(A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.

(B) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

(C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.

(D) (B) and (C).

(E) None of the above.

The model answer is selection B.

In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (B) is true and (A) is not. (D) is incorrect since the people at MC were not the true inventors. (E) is incorrect inasmuch as (B) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that Eve could be added to MC Motors patent application and would then be entitled to a patent.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Eve could be added to MC Motors patent application and would then be entitled to a patent, the instructions state "Do not assume any additional facts not presented in the questions", and there is no reason to assume that Eve would be added to MC Motors' application. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make an amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2

that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (A) is correct. Petitioner contends that answer (C) is incorrect because it fails to include the drawing amendment in the regular amendment letter, and this is more wrong than failing to provide a red ink correction drawing.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (C) is incorrect because it fails to include the drawing amendment in the regular amendment letter, and this is more wrong than failing to provide a red ink correction drawing, MPEP § 608.02(r) requires drawing corrections to be submitted in a separate paper, making (C) correct and not incorrect. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no point have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy